

## **REMARKS/ARGUMENTS**

### ***Double Patenting***

1. Nonstatutory double patenting rejections were given by the examiner. Enclosed please find a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) thereby overcoming said rejections.

### ***Claim Rejections - 35 USC § 103***

2. The Examiner rejected claims 1-6 and 13 under §103(a) as being unpatentable (obvious) in view of Cimorell et al. (USPN 6,612,046) in view of Kolody (USPN 3,646,885).

3. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP § 706.02(j).

4. The last of these criteria (“the prior art reference (or references when combined) must teach or suggest all the claim limitations”) is the appropriate place to begin the analysis of the present invention’s claims in view of the prior art.

5. Claim 1 of the present invention has been amended to add limitations that:

- a. the measuring tape be configured to be extendible in a first direction out of the housing with the remainder of the tape being coiled in said housing, and the wheel is disposed generally perpendicular to said first direction; and
- b. the mark so applied is generally perpendicular to the first direction.

6. The limitation of paragraph 5a above is from claim 2 (which has been subsequently canceled). Such change adds no new matter.

7. The limitation of paragraph 5b above is clearly supported in the disclosure and drawings. For instance, paragraph [0143] talks about the rotational transfer of the marking indicia to the surface to be marked thereby creating a mark and that the wheel be generally disposed perpendicular to the first direction. If the wheel is perpendicularly disposed and the mark is rotationally transferred, clearly the mark so applied is generally perpendicular to the first direction. Thus, the mark applied is parallel to the rotation of the wheel. Such change adds no new matter.

8. In that the combination of Cimorell et al and Kolody do not meet the criteria of "the prior art reference (or references when combined) must teach or suggest all the claim limitations," the present invention is not obvious in view of the prior art. For instance, Kolody shows an inked wheel used to transfer a plurality of measurement scale marks to a surface, said marks being perpendicular to the rotation of the wheel.

9. For the sake of argument, Applicant offers the following additional points regarding why the claims are not obvious in view of the cited references:

- a. Cimorell teaches placing a single mark by striking, with the marking utensil retracted then back into the housing. When the utensil is being extended, it is inked. Thus, for Cimorell to work and be accurate, the housing needs to be held generally still while the mark is made.
- b. Kolody teaches an applicator for a roll-on measurement scale. Kolody is not configured for rolling on a line parallel to the direction the wheel is rolling, but on the contrary is configured for making a number of marks that are perpendicular to the direction the wheel revolves.
- c. Thus, Cimorell teaches away from Kolody and vice versa.
- d. Thus, there is no motivation to combine.
- e. It is submitted that the combination of Kolody's wheel with Cimorell's tape measure is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in Applicant's claims. In particular, the references do not disclose, teach or suggest the mark so applied being generally perpendicular to the first direction and parallel to the rotation of the wheel.

10. As such, the present invention, as claimed, is not obvious in view of the cited prior art references.

***Non-Analogous Prior Art***

11. Only references from arts analogous to that of the claimed invention may comprise prior art to the invention. A reference will only be analogous art if: 1) it is from the same field of endeavor as the claimed invention; or 2) it is from a different field of endeavor, but the reference is reasonably pertinent to the particular problem solved by the inventor. *In re Oetiker*, 977 F.2d 1443, 1446-47 (Fed. Cir. 1992); *In re Clay*, 966 F.2d 656, 658-89 (Fed. Cir. 1992). In the *In re Clay* case, the subject claims were directed to a process that improved removal of oil products from storage tanks. The Examiner in that case cited a patent directed to improving production of oil from underground formations. The Federal Circuit held that the cited patent is not analogous art even though the cited patent and subject application both related to the oil industry.

12. The Kolody reference is not within the field of Applicant's endeavor and not reasonably pertinent to the particular problem with which the inventor was concerned because a person of ordinary skill, seeking to solve a problem of marking tape measures would not reasonably be expected or motivated to look to scale pattern and route conversion markers.

***Conclusion***

Applicant believes that after the above amendment, all of the claims of the present application are allowable, and Applicant requests the same. If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below. Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 13<sup>th</sup> day of January 2004.

Very respectfully,



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CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service on the below date as first class mail in an envelope addressed to:

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DATE: January 13, 2005

  
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Amber R. Smith